

REMARKS

By this Amendment, Applicants submit herewith a Declaration Under 37 C.F.R. § 1.131 in response to the claim rejections under 35 U.S.C. §§ 102 and 103 discussed below. No claims are canceled, amended or added by this Amendment. Claims 24 and 25 were withdrawn from further consideration pursuant to the Response To Restriction Requirement filed June 17, 2003 (Paper No. 4). As a result, claims 1-23 are pending in the application.

Claim Rejections – 35 U.S.C. § 102

Pursuant to paragraphs 3 and 4 of the above-referenced Office Action, claims 1-4, 6, 7, 9-12, 15-18 and 20-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,542,673 to Holter et al. (“the ‘673 patent”). With respect to independent claim 1, the Examiner asserts that “Holter et al. discloses a ferrule body (304) defining a forward end (304a), and opposed rearward end, and at least one passageway extending between the forward end and the rearward end; and a fiber optic indicia (310) formed on a predetermined portion of a surface of the ferrule, wherein the fiber optic indicia comprises a predetermined pattern associated with data about the fiber optic assembly, herein the data comprises at least one of an optical characteristic and a product characteristic.” With respect to independent claim 9, the Examiner asserts that “Holter et al. discloses a method of marking a fiber optic component including the steps of: establishing a predetermined patter[n] of a fiber optic indicia, wherein the fiber optic indicia is associated with information about the fiber optic component; providing the component for marking; preparing a predetermined portion of the surface of the component for marking; and marking the predetermined portion of the surface in accordance with the predetermined pattern of the fiber optic indicia.” With respect to independent claim 21, the Examiner asserts that “Holter et al. discloses a method of marking a ferrule including the steps of: establishing a predetermined pattern of a fiber optic indicia, wherein the fiber optic indicia is associated with information about the fiber optic assembly; providing the ferrule for marking; preparing a predetermined portion of a surface of the ferrule for marking; marking the predetermined portion of the surface in accordance with the predetermined pattern of the fiber optic indicia ...”

Applicants respectfully traverse the rejection in view of the Declaration of the inventors filed concurrently herewith. The Declaration clearly establishes that Applicants conceived and reduced to practice the inventions of claims 1-23 in this country prior to the effective priority filing date (i.e., May 25, 1999) of the '673 patent. The '673 patent is a continuation-in-part of U.S. Patent Application No. 09/318,451 filed on May 25, 1999, which issued on June 11, 2002, as U.S. Patent No. 6,404,953 ("the '953 patent"). The '953 patent is a continuation-in-part of U.S. Patent Application No. 08/819,979 filed on March 13, 1997, which issued on September 14, 1999, as U.S. Patent No. 5,953,477 ("the '477 patent"). Thus, the '673 patent claims the benefit of priority from the earlier filed '953 patent and '477 patent. The '673 patent also claims the benefit of priority from U.S. Provisional Application No. 60/213,983 filed on June 24, 2000.

The '953 patent merely discloses a mask 12 comprising a filter 13 that is positioned adjacent the end of an optical fiber 11. The mask 12 further comprises an identifier space 15 (FIG. 1), 35 (FIG. 3); 45 (FIG. 4); 55 (FIG. 5); and 65 (FIG. 6) "reserved for a micro bar code, magnetic or other identification information that will assist in assuring appropriate alignment and mating of the optical assemblies." '953 patent at column 5, lines 57-60. Beginning at column 5, line 60, the purpose and content of the identifier space is further described as:

For example, the mask dimensions and characteristics could be identified. In addition, the fiber's core and polarization axes can be identified with respect to the location of the identifier and the mask aperture location, configuration and dimensions. Also, the core dimension and location can be identified. When fiber to fiber connections are made, often testing and aligning can be a time consuming task. Proper information in the identifier space could minimize the testing burden. Using code in identifier space 15 to reference specific, detailed computer link information would allow for unlimited information about the optical assembly. The identifier information could be located at other locations *on the mask*, but the space is desirably located where it could be used in automating manufacturing systems. If the optical assembly is likely to be end to end connected to another assembly in which subsequent identification is useful, for example as illustrated in FIG. 6, and FIG. 7, an identifier on the edge can be used. (Emphasis added).

The '477 patent *provides no disclosure of*: a ferrule comprising a fiber optic indicia formed on a predetermined portion of a surface of the ferrule (i.e., claim 1); a method of marking

a predetermined portion of a surface of a component of a fiber optic assembly in accordance with a predetermined pattern of a fiber optic indicia (i.e., claim 9); or a method of marking a ferrule of a fiber optic assembly in accordance with a predetermined pattern of a fiber optic indicia (i.e., claim 21). Based on the disclosures of the '953 patent and the '477 patent, the earliest effective filing date attributable to the subject matter of the '673 patent that is relevant to the inventions of claims 1, 9 and 21 of the present application is the filing date of the '953 patent (i.e., May 25, 1999). In other words, the chain of priority for the disclosure of subject matter that relates to the marking of a fiber optic component of a fiber optic assembly with a fiber optic indicia associated with information about the fiber optic assembly begins with the filing date of the '953 patent and does not extend to the filing, or priority, date of the '477 patent.

The inventions embodied in claims 1-23 of the present application were completed (i.e., conceived and reduced to practice) in this country or in a NAFTA or WTO member country before May 25, 1999, the effective priority filing date of the '673 patent. Declaration at paragraph 7. The inventions embodied in claims 1-23, and in particular, the independent claims 1, 9 and 21, of the present application are described in an electronic mail communication from an inventor (i.e., Joel C. Rosson) of the subject matter of the pending claims 1-23 dated October 1, 1998 (hereinafter "the Rosson email"), a true and correct redacted copy of which is attached to the Declaration as Exhibit A. Declaration at paragraph 8. The Rosson email shows and describes a ferrule comprising a ferrule body defining a forward end, an opposed rearward end (inherent) and at least one passageway extending between the forward end and the rearward end. The Rosson email further shows and describes a fiber optic indicia (i.e., S15; 98; 362; ZZZZ) formed on a portion of a surface of the ferrule (i.e., the endface) wherein the fiber optic indicia comprises optical characteristic and/or product characteristic data about the ferrule assembly (i.e., fiber mode; ferrule OD; fiber bore concentricity/eccentricity; serialized date code) arranged in a predetermined pattern. Thus, at least claim 1 of the present application was conceived and reduced to practice prior to the effective priority filing date of the '673 patent. Declaration at paragraph 9. The Rosson email shows and describes a method of marking a component of a fiber optic assembly with a predetermined pattern of a fiber optic indicia associated with information about the fiber optic assembly by marking a predetermined portion of the surface of the

component in accordance with the predetermined pattern of the fiber optic indicia. Thus, at least claim 9 of the present application was conceived and reduced to practice prior to the effective priority filing date of the '673 patent. Declaration at paragraph 10. The Rosson email shows and describes a method of marking a ferrule of a fiber optic assembly with a predetermined pattern of a fiber optic indicia associated with information about the fiber optic assembly by marking a predetermined portion of the surface of the ferrule in accordance with the predetermined pattern of the fiber optic indicia. Thus, at least claim 21 of the present application was conceived and reduced to practice prior to the effective priority filing date of the '673 patent. Declaration at paragraph 11.

For at least the reasons stated above, the '673 patent is unavailable to be applied as a prior art reference against independent claims 1, 9 and 21. Thus, the rejection is improper and claims 1, 9 and 21 are patentable *vis a vis* the '673 patent. Claims 2-4, 6 and 7 depend directly or indirectly from patentable base claim 1, and thus, are likewise allowable for at least the same reasons. Claims 10-12, 15-18 and 20 depend directly or indirectly from patentable base claim 9, and thus, are likewise allowable for at least the same reasons. Claims 22 and 23 depend directly from patentable base claim 21, and thus, are likewise allowable for at least the same reasons. Accordingly, Applicants submit that the Declaration is effective to overcome the '673 patent as a prior art reference and respectfully request the Examiner to withdraw the rejection of claims 1-4, 6, 7, 9-12, 15-18 and 20-23 under 35 U.S.C. § 102(e).

Pursuant to paragraph 5 of the above-referenced Office Action, claims 12 and 13 [sic: 13 and 14] stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0003934 to Clark ("the 2002/3934 application"). The Examiner asserts that "Clark also discloses that the indicia used to mark the [fiber optic] component may include applying color or a combination of colors in order to identify the component."

Applicants respectfully traverse the rejection in view of the Declaration of the inventors filed concurrently herewith. The Declaration clearly establishes that Applicants conceived and reduced to practice the inventions of claims 1-23 in this country prior to the effective priority

filing date (i.e., October 29, 1999) of the 2002/3934 application. The 2002/3934 application is a division of U.S. Patent Application No. 09/429,644 filed on October 29, 1999, which issued on August 28, 2001 as U.S. Patent No. 6,282,353 (“the ‘353 patent”) and a division of U.S. Patent Application No. 09/429,641 filed on October 29, 1999 (“the ‘641 application”). Thus, the 2002/3934 application claims the benefit of priority from the earlier filed ‘353 patent and the ‘641 application. Declaration at paragraph 12. The 2002/3934 application, the ‘353 patent and the ‘641 application merely disclose a *label* or *sleeve* for protecting one or more optical fiber fusion splices. The label is provided with a unique indicium, such as text, numbers, alphanumerical text, a symbol or symbol combination, bar coding, a pattern, graphics, a shape, a picture, an image, a holographic image, Braille, a signature, a trademark, a color or color combination, a marking, an engraving and/or relief, an icon, a texture and/or data within a memory of an electronic memory device, such as a microchip. Declaration at paragraph 13. The inventions embodied in at least independent claims 1, 9 and 21 of the present application were completed (i.e., conceived and reduced to practice) in this country or in a NAFTA or WTO member country before October 29, 1999, the effective priority filing date of the 2002/3934 application. Declaration at paragraph 14.

For at least the reasons stated above, the 2002/3934 application is unavailable to be applied as a prior art reference against independent claims 1, 9 and 21. Thus, the rejection is improper and claims 1, 9 and 21 are patentable *vis a vis* the 2002/3934 application. Claims 13 and 14 depend directly from patentable base claim 9, and thus, are likewise allowable for at least the same reasons. Accordingly, Applicants submit that the Declaration is effective to overcome the 2002/3934 application as a prior art reference and respectfully request the Examiner to withdraw the rejection of claims 12 and 13 [sic: 13 and 14] under 35 U.S.C. § 102(e).

Claim Rejections – 35 U.S.C. § 103

Pursuant to paragraphs 6-8 of the above-referenced Office Action, claims 5, 8 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable (i.e., obvious) over the ‘673 patent. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify the optical component of the '673 patent to: locate the indicia within at least about 150 microns from the opening of the at least one passageway; select any suitable material for the making the ferrule; and include any relevant performance information within the markings applied to the optical component.

Applicants respectfully traverse the rejection in view of the Declaration of the inventors filed concurrently herewith. The Declaration clearly establishes that Applicants conceived and reduced to practice the inventions of claims 1-23 in this country prior to the effective priority filing date (i.e., May 25, 1999) of the '673 patent. For at least the reasons stated above, the '673 patent is unavailable to be applied as a prior art reference against independent claims 1, 9 and 21. Thus, the rejection is improper and claims 1, 9 and 21 are patentable *vis a vis* the '673 patent. Claims 5 and 8 depend directly or indirectly from patentable base claim 1, and thus, are likewise allowable for at least the same reasons. Claim 19 depends indirectly from patentable base claim 9, and thus, is likewise allowable for at least the same reasons. Accordingly, Applicants submit that the Declaration is effective to overcome the '673 patent as a prior art reference and respectfully request the Examiner to withdraw the rejection of claims 5, 8 and 19 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the Declaration of the inventors filed concurrently herewith and the foregoing remarks, Applicants respectfully request the Examiner to withdraw the rejections to the pending claims 1-23 and to reconsider the application. This Amendment is fully responsive to the Office Action and places the application in condition for immediate allowance. Accordingly, Applicants respectfully request the Examiner to issue a Notice of Allowability for claims 1-23. The Examiner is encouraged to contact the undersigned directly to further the prosecution of any remaining issues, and thereby expedite allowance of the application.

This Amendment does not result in more independent or total claims than paid for previously. Accordingly, no fee for excess claims is believed to be due. The Examiner is hereby authorized to charge any fee due in connection with the filing of this response to Deposit Account No. 19-2167. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not already accounted for, such an extension is requested and the fee should also be charged to Deposit Account No. 19-2167.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Dremann', with a horizontal line extending to the right.

Christopher C. Dremann
Attorney for Applicants
Registration No. 36,504
P. O. Box 489
Hickory, N. C. 28603
Telephone: 828/901-5904
Facsimile: 828/901-5206

Dated: November 12, 2003